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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,401	12/15/2003	Seishi Ohmori	P2060US	6201

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DRINKER BIDDLE & REATH LLP
ATTN: PATENT DOCKET DEPT.
191 N. WACKER DRIVE, SUITE 3700
CHICAGO, IL 60606

EXAMINER

NEGRON, WANDA M

ART UNIT	PAPER NUMBER
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2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/736,401

Applicant(s)

OHMORI, SEISHI

Examiner

Wanda M. Negrón

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 5, 6, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamagata (US 5,764,800).**

4. Regarding **claim 1**, Yamagata discloses a method of managing storage space in a digital camera, the method comprising (a) allowing a user to set a number of image files to be added to a recording medium of the digital camera, i.e. completely depressing the release button while in a compression mode, after the number of image files recordable, if recompression is performed, has been displayed (see step 110 and col. 5, lines 46-60); (b) determining which existing image files should be recompressed (step 111) and the rate at which recompression should occur so as to create sufficient storage space in the recording medium to store the number of additional files set by the user (step 112); (c) restoring the image files selected to be recompressed (see col. 4, lines 4-16); (d) recompressing the restored image files at the determined recompression

rate (step 112); and (e) storing the recompressed image files in the recording medium (step 115).

5. Regarding **claim 5**, Yamagata discloses that the recording medium (M) is removable from the digital camera (see figure 1).

6. Regarding **claim 6**, Yamagata discloses that the recording medium (M) is a memory card (see col. 2, lines 61-63).

7. Regarding **claim 9**, Yamagata discloses that the recompression, i.e. a higher compression mode, utilizes the JPEG standard (see col. 4, lines 1-3).

8. Regarding **claim 10**, Yamagata discloses that the digital camera includes a display unit (13).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2-4, 7, 8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagata (US 5,764,800).**

11. Regarding **claim 2**, as mentioned in the discussion of claim 1 above, Yamagata discloses all the limitations of the parent claim. In addition, Yamagata teaches the steps of, (f) determining whether an image file exists that is not already recompressed (step

105); and (g) if an image file exists that has not been recompressed, displaying a menu indicating the number of files to be added to the recording medium of the digital camera (step 109 and col. 5, lines 34-41).

However, Yamagata does not explicitly disclose the steps of, (h) displaying a message indicating that all existing image files have been recompressed and asking the user for permission to further recompress existing image files, if all existing image files have been recompressed; (i) determining whether user has granted permission to further recompress existing image files; (j) if the user denies permission, terminating the method, and (k) if the user grants permission, displaying a menu indicating the number of files to be added to the recording medium.

Steps (h), (i), (j), and (k) are associated with authorization to perform a higher recompression ratio on previously recompressed image data. Official notice is taken that the use of higher recompression ratios decreases the image quality. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to ask the user for authorization for further recompression of previously recompressed data because it would prevent further degradation of significant images.

12. Regarding **claim 3**, Yamagata discloses the step of, (l) determining if a recompression function has been selected (step 101).

13. Regarding **claim 4**, Yamagata discloses that step (l) comprises determining whether a recompression button has been pressed, i.e. the user actuates mode selection button 14 to select a compression mode (see col. 4, lines 50-55).

14. Regarding **claims 7 and 8**, Yamagata does not explicitly teach that the recording medium (M), i.e. an IC memory card, is a compact flash card or a memory stick. Official notice is taken that CompactFlash and Memory Stick are a well-known standards for IC memory cards. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use CompactFlash and Memory Stick standards as the IC memory card taught by Yamagata since doing so would make the recording medium directly compatible with other peripherals, e.g. printers, other digital cameras, etc.

15. Regarding **claim 11**, Yamagata does not explicitly disclose that the display unit (13) is an LCD screen. Official notice is taken that the use of an LCD as a camera display is well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used an LCD device as a display unit in the invention of Yamagata since an LCD requires less amount of electric power to operate, thus, saving the battery power of the camera.

16. Regarding **claim 12**, Yamagata discloses that steps f, g, h, i, j, and k are performed before steps a, b, c, d, and e (see figures 4A and 4B).

17. Regarding **claim 13**, Yamagata discloses that step (l) is performed first, and steps f, g, h, i, j, and k are performed before steps a, b, c, d, and e (see figures 4A and 4B).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2622

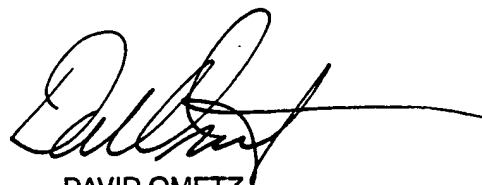
- Torres (US 6,564,282 B1) discloses a method and a system for increasing storage capacity by recompressing previously recorded files.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wanda M. Negrón whose telephone number is (571) 270-1129. The examiner can normally be reached on Mon-Fri 6:30 am - 4:00 pm alternate Fri off.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Wanda M. Negrón
January 31, 2007



DAVID OMETZ
SUPERVISORY PATENT EXAMINER